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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,607	08/07/2006	Masahiko Itakura	2224-0258PUS1	9585
2292 7590 10/20/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER JOY, DAVID J	
			ART UNIT 1794	PAPER NUMBER
			NOTIFICATION DATE 10/20/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/588,607	Applicant(s) ITAKURA ET AL.	
	Examiner David J. Joy	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-26 is/are pending in the application.
- 4a) Of the above claim(s) 12-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11 and 18-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/07/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group III, Claims 9-11, in the reply filed on July 2, 2009 is acknowledged. The traversal is on the grounds that the search and examination of the entire application can be made without a serious burden to the examiner. This is not found persuasive because, as discussed in the Written Restriction for Lack of Unity, mailed on June 4, 2009, the inventions claimed in the present application are not so linked as to form a single general inventive concept under PCT Rule 13.1, there was a definitive finding of lack of unity *a posteriori*, and there are significant differences between the claimed group of inventions.
2. The requirement is still deemed proper and is therefore made FINAL.
3. Claims 12-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected groups, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 2, 2009.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Appropriate correction is required.

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

7. Claim 26 is objected to because of the following informalities: the first line of the claim recites "*herein* the printed layer" (emphasis added). Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 18 and 19 recite the limitation "the absorbing part" and Claim 19 recites the limitation "the absorbing layer". There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 9, 18 and 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by the U.S. Patent Application Publication of Joachimi et al. US 2003/0130381; hereinafter “Joachimi”).

12. Joachimi teaches a laser-weldable label (“laser-absorbing molding part”) which comprises a resin layer (“thermoplastic material”) and a laser-absorbing part (“component B”) which can be applied to the surface of the resin layer (see Abstract; see also ¶¶ [0024], [0025] and [0101]). Specifically, Joachimi provides that the additives that can be included with the laser-absorbing resin composition can be mixed with the thermoplastic resin material, or they can be applied to the surface (*Id.*). Joachimi also teaches that the laser-absorbing part has a transmittance of greater than 15% in the wavelength range from 700 to 1200 nm (see ¶ [0032]). In addition, Joachimi recites that the laser-absorbing part has a thickness of 0.4 to 6 mm, and that the resin layer

comprises a thermoplastic resin such as a styrenic resin, an acrylic resin, an olefinic resin, a vinyl resin, a thermoplastic polyester resin, a polyamide resin, and a polycarbonate resin (see ¶¶ [0032] and [0033]). Specifically, Joachimi recites that the thermoplastic resin can also be a ketone, a polyamide, a polystyrene, ABS, and polybutylene terephthalate (see ¶¶ [0033], [0034], [0037] and [0042]). Further, Joachimi teaches that the resin layer contains a coloring component that can either be a chromatic coloring component or an achromatic coloring component (see ¶¶ [0103]-[0109], [0115], [0121] and [0130]-[0134]).

13. Joachimi is silent as to the light-scattering property, haze value, and the total light transmittance according to ASTM D1003. However, as Joachimi teaches a laser-absorbing molded part that has the same composition as that which is presently claimed, it follows that the laser-absorbing part will inherently possess the aforementioned properties. The claiming of a new use, new function or unknown property, which is inherently present in the prior art, does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause claim language drawn to those things to be distinguishable over prior art. The Office can require Applicant to prove that subject matter shown to

be in prior art does not possess a characteristic relied upon where it has reason to believe that a functional limitation asserted to be critical for establishing novelty in claimed subject matter may be an inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics or properties.

14. In Claims 9 and 18, the recitation of such limitations as "the label is affixable or weldable to a resin shaped article by irradiating a laser beam" (Claim 9) and "is weldable to the resin shaped article by bringing the absorbing part of the label into contact with the resin shaped article and irradiating a laser beam" (Claim 18) do not positively recite and definite structure over that which is taught in the Joachimi reference. Applicant has simply recited possible aspects of which the label are *capable*, which merely refer to potential, future, intended uses of the label. Furthermore, the intended use of the label fails to define anything structurally distinct over that which is taught by Joachimi.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 10, 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joachimi, as applied to Claim 9 above, in view of the U.S. Patent Application Publication of Katayama et al. (US 2004/0045663; hereinafter “Katayama”).

18. Joachimi teaches a laser-absorbing molding part, as discussed hereinabove. However, Joachimi fails to teach or suggest that the laser-absorbing part is a laser-absorbing layer on the surface of the resin layer. Katayama, which is drawn to a multilayer laser welding material, teaches that a first resin layer can be coupled to a second resin layer that is laser light-absorbing (see Abstract; see ¶¶ [0010]-[0019]).

While Katayama does not show that the laser-absorbing layer has a thickness of 1 μm to 40 μm , as in Claim 10, such thicknesses are properties which can be easily determined by a person having ordinary skill in the art. With regard to the limitation of the thickness of a substituent layer, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. changing the thickness of a layer) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they directly affect the performance of the laser-absorbing material. It would have been obvious to a person having ordinary skill in the art, at the time of invention, to make the multilayer laser-welding material with the limitations of the thickness of the laser-absorbing layer since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980). Given that both Joachimi and Katayama are drawn to the same field of invention, it would have been obvious to a person having ordinary skill in the art at the time of invention to have made the laser-absorbing molding part taught by Joachimi, and to incorporate the separate laser-absorbing layer taught by Katayama, thereby arriving at the presently-claimed invention.

19. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joachimi, as applied to Claim 9 above, in view of the U.S. Patent Application Publication of Koops et al. (US 2003/0104309; hereinafter "Koops").

20. Joachimi teaches laser-absorbing molding part, as discussed hereinabove.

However, Joachimi fails to teach or suggest the inclusion of a printed layer on the laser-absorbing material. Koops, which is drawn to a laser transfer film for durable inscription on components, teaches that the laser transfer film can be inscribed with information concerning the item to be labeled (i.e., the laser film can have a display function) (see ¶ [0004]). Koops also teaches that the durable inscription can be made from at least one backing layer, wherein a pigment layer can be applied to at least part of the backing layer (see ¶ [0022] and [0023]). Given that both Joachimi and Koops are drawn to the same field of invention, it would have been obvious to a person having ordinary skill in the art at the time of invention to have made the laser-absorbing molding part taught by Joachimi, and to incorporate the printed information layer taught by Koops, thereby arriving at the presently-claimed invention.

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on (571) 272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DJJ/

Examiner, Art Unit 1794

09/28/2009

/Bruce H Hess/

Primary Examiner, Art Unit 1794